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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/764,075 | 01/23/2004 | Thomas Briese | 0019240.00447US2 | 7998 |
| 56949 | 7590 | 11/28/2007 | | |
| WilmerHale/Columbia University 399 PARK AVENUE NEW YORK, NY 10022 | | | | |
| | | | EXAMINER | |
| | | | HUMPHREY, LOUISE WANG ZHIYING | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1648 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 11/28/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---|--------------------------------------|--|
| Office Action Summary | Application No. 10/764,075 | Applicant(s) BRIESE ET AL. | |
| | Examiner Louise Humphrey, Ph.D. | Art Unit 1648 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-32 and 34-75 is/are pending in the application.
- 4a) Of the above claim(s) 11-24, 46-60 and 62-75 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45 and 61 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10, 25-32, 34-38 and 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the amendment filed 15 October 2007.

Claims 7, 33, 39 and 40 have been cancelled. Claims 1-6, 8-32, and 34-75 are pending. Claims 11-24, 46-60, and 62-75 are withdrawn. Claims 1-6, 8-10, 25-32, 34-38, 41-45, and 61 are examined. Claims 45 and 61 are allowable.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

NEW MATTER REJECTION

The rejection of claims 1-6, 8-10, 25-32, 34-38 and 41-44 under 35 U.S.C. §112, first paragraph, as containing NEW MATTER is **maintained**. Applicants' arguments are fully considered but are not persuasive.

Applicants argue that the 3'-non-coding region and a portion of the N-gene region are depicted in SEQ ID NO: 1 and SEQ ID NO: 43. However, Applicants' arguments lack evidentiary basis. The paragraph [0009] and [0011] in the specification does not describe a nucleic acid consisting of from 19 to **about** 30 consecutive nucleotides of SEQ ID NO:43. The disclosure of a synthetic nucleic acid comprising 10-30 consecutive nucleotides of SEQ ID NO:1 does not support the claimed limitation of "19 to **about** 30" consecutive nucleotides because "**about** 30" can mean any number from 25 to 35. The word "about" does not set the upper limit of the claimed range as 30.

SCOPE OF ENABLEMENT REJECTION

The rejection of claims 1-6, 8-10, 25-32, 34-38, and 41-44 under 35 U.S.C. §112, first paragraph, as containing the recitation "**a** sequence" which was not described in the specification commensurate in scope, while being enabling for "**the** sequence" is **withdrawn** in consideration of Applicants' arguments.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

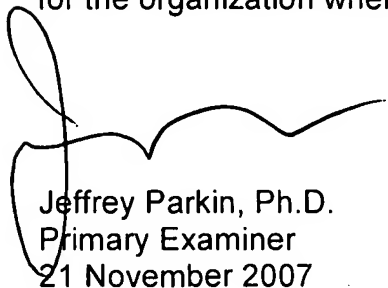
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 1648

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louise Humphrey, Ph.D. whose telephone number is 571-272-5543. The examiner can normally be reached on Mon-Fri, 9:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached at 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Jeffrey Parkin, Ph.D.
Primary Examiner
21 November 2007



Louise Humphrey, Ph.D.
Assistant Examiner